case when the warrant was ordered to be issued a day after the laying of the information but the accused was arrested on August 18, 1981 which was more than six months from the date of the seizure of the tapes. Again the warrant of arrest which was ordered to be issued on July 29, 1981 was duly signed and sealed but was left undated. This was also a serious defect which rendered the warrant invalid and one that could not be acted upon. If the seizure of the tapes had been lawful the arrest of the accused on August 18, 1981 was outside the six months' limit and therefore the magistrate's court had no jurisdiction to hear the case.

Kampar Arrest Case No. A185/1981

In this case the police raided the premises of the accused and seized copies of the video tapes on January 13, 1981 without any search warrant. This was a serious irregularity rendering the search and seizure of the video tapes illegal. Proceedings under section 15(1) of the Copyright Act can only commence if the infringing copies are lawfully seized under section 15(4) and not otherwise. Therefore the arrest of the accused on July 7, 1981 on a warrant of arrest and all subsequent proceedings were invalid.

Conclusion

The irregularities in both cases were far too serious and cannot be cured under section 422 of the Criminal Procedure Code. It is well over two years now since the police started to work on these two cases so that it will be harsh and unreasonable for any further action to be taken against these two persons. In the interest of justice I order that the accused be acquitted and discharged and the tapes be returned to them.

Order accordingly.

Solicitors: *Asbir, Hira Singh & Co.*

TELEVISION BROADCASTS LTD. & ORS. v. MANDARIN VIDEO HOLDINGS SDN. BHD.

[O.C.J. (Chan J.) May 19, 1983]
[Kuala Lumpur – Civil Suit No. C2427 of 1982]

Copyright – Piracy – Claim against videopirates – Ex parte application – Anton Piller order sought for – Order allowed by Court.

Copyright – When copyright subsists – Films must be published in Malaysia within 30 days of their being first shown in any country – Meaning of "published" in s. 2(2)(a) – Copyright Act 1969, ss. 2(2)(a) & 6(1).

Practice & Procedure – Anton Piller order sought for – Ex parte application against videopirates – Order granted by Court.

Evidence – Self-incrimination evidence – Privilege against – Effect of Anton Piller order on self-incrimination evidence – Privilege withdrawn by Evidence Act 1950, s. 132(2).

Censorship – Censorship Certificate – Offence to exhibit, sell, hire or distribute film without certificate – Films (Censorship) Act 1952, ss. 9(2), 9A(2), 15(1)(a) & 25(1)(d).

The first 2 plaintiffs, TVB and RTV were producers of the television series and programmes which were shown on Hong Kong Television. TVB and RTV were owners of the copyright in those television films or soap operas. The third plaintiff Golden Star had the exclusive right from them to reproduce those films on video cassettes for distribution to their dealers or outlets for hiring out to the public. From investigations conducted by Golden Star, the defendants had been hiring out pirated copies of their television series on the black market. They had not given permission to the defendants to make copies of or put on video cassettes their films. The plaintiffs therefor sought for an *ex-parte* order, the *Anton Piller* order before the Writ was even served against the defendants. The plaintiffs wanted to take the defendants by surprise so that they could not get rid of incriminating evidence and their stock of infringing video cassettes. The plaintiffs therefore feared that unless they obtain an *Anton Piller* order the defendants would easily remove, destroy or erase incriminating documents and articles. The said order was granted by the present court. The defendants objected on the following grounds:

(a) the defendants claimed privilege against self-incrimination;

(b) the plaintiffs had allegedly committed offences contrary to section 15(1) of the Films (Censorship) Act 1952, they lost their copyright to the films;

(c) the films were not made available in sufficient quantities to satisfy the reasonable requirement of the public under section 2(2)(a) of the Copyright Act 1969.

Held: (1) there was a strong *prima facie* case against the defendants that the plaintiffs had been dealing in illicit films and that the plaintiffs had satisfied the requirements for the making of an *Anton Piller* order,

(2) the usefulness of the *Anton Piller* order is on the element of surprise. This is so essential in cases of piracy. If the pirates have been forewarned then vital documents and articles would be lost, hidden or destroyed;

(3) the defendants in this case were dealing with pirated video cassettes which infringed the plaintiffs' rights;

(4) in this country the privilege against self-incrimination has been withdrawn: section 132 of the Evidence Act 1950. In view of section 132(3), the *Anton Piller* order had to be modified to carry a statement in terms of section 132(2). The defendants must be informed that the answers given by them in response of the order will not subject them to the risk of arrest or prosecution and that their evidence will not be used in any criminal proceedings, except a prosecution for giving false evidence by their answers;

(5) section 15(1)(a) of the Films (Censorship) Act 1952 makes it an offence to exhibit, sell, hire or distribute any film without a certificate. The court, however, ought to be very slow to hold that the Films (Censorship) Act 1952 intends to interfere with the rights and remedies given by the ordinary law of copyright;

(6) if Golden Star had infringed the Films (Censorship) Act 1952 then they could be prosecuted and they would have to pay the penalty. However, their rights under the Copyright Act 1969 remained and could be enforced;

(7) for copyright to subsist, the films must be published in Malaysia within 30 days of their being first shown in any country, in this case, Hong Kong;

(8) for the films to be published within the meaning of section 2(2)(a) of the Copyright Act 1969, it is enough if they were on offer and sufficient copies were available to meet the anticipated public demand. In this case the video cassettes were with the dealers, who being businessmen, were prepared to supply on demand. The plaintiffs need not prove any positive acts of offer;

(9) TVB and RTV as makers of the film could, by virtue of section 2(1) of the Copyright Act 1969, sue. Golden Star as the exclusive licensee could also sue. Should Golden Star merely have a licence and not an exclusive licensee, they were proper parties so long as they had joined TVB and RTV as co-plaintiffs.

[Editorial Note: The appeal against the above judgment has been struck off by the Federal Court in F.C.C.A. No. 165 of 1983.]

Cases referred to:

(1) *Rank Film Ltd.* v. *Video Information Centre* [1982] A.C. 380, 403
(2) *Public Prosecutor* v. *Chan Kam Lai* [1983] 2 M.L.J. 344.
(3) *Kuruma* v. *The Queen* [1955] A.C. 197.
(4) *Anton Piller KG* v. *Manufacturing Processes Ltd.* [1976] Ch. 55.
(5) *Lian Keow Sdn. Bhd.* v. *Paramjothy* [1982] 1 M.L.J. 217.
(6) *E.M.I. Ltd.* v. *Pandit* [1975] 1 W.L.R. 302.
(7) *Ex Parte Island Records Ltd.* [1978] Ch. 122, 133.
(8) *International Electronics Ltd.* v. *Weigh Data Ltd.* [1980] F.S.R. 423, 426, 427; *Times*, March 13, 1980.
(9) *Universal City Studios Inc.* v. *Mukhtar & Sons Ltd.* [1976] 1 W.L.R. 568.
(10) *Yousif* v. *Salama* [1980] 1 W.L.R. 1540, 1541-1542; 3 All E.R. 405.
(11) *Lincoln International Ltd.* v. *Eagleton Direct Exports Ltd.* [1982] F.S.R. 161.
(12) *In re Westinghouse Uranium Contract* [1978] A.C. 547, 574
(13) *Triplex Safety Glass Co. Ltd* v. *Lancegaye Safety Glass (1934) Ltd.* [1939] 2 K.B. 395, 403.
(14) *Redfern* v. *Redfern* [1891] P. 139, 147.
(15) *R.* v. *Boyes* (1861) 1 B & S. 311, 330; 121 E.R. 730.
(16) *C.B.S. United Kingdom Ltd.* v. *Lambert* [1983] F.S.R. 127.
(17) *Chye Ah San* v. *R.* [1954] M.L.J. 217.
(18) *Lamb* v. *Munster* (1882) 10 Q.B.D. 110, 111.
(19) *M.P. Sharma* v. *Satish Chandra* [1954] S.C.R. 1077.
(20) *State of Bombay* v. *Kathi Kalu Oghad* [1962] 3 S.C.R. 10, 41.
(21) *Victorian Daylesford Syndicate* v. *Dott* [1905] 2 Ch. 624.
(22) *Anderson Ltd.* v. *Daniel* [1924] 1 K.B. 138.
(23) *St. John Shipping Corp.* v. *Joseph Rank Ltd.* [1957] 1 Q.B. 267.
(24) *Shaw* v. *Groom* [1970] 2 Q.B. 504.
(25) *Francis, Day & Hunter* v. *Feldman & Co.* [1914] 2 Ch. 728.
(26) *British Northrop Ltd.* v. *Texteam Blackburn Ltd.* [1974] R.P.C. 57.
(27) *Infabrics Ltd.* v. *Jaytex Ltd.* [1980] 1 Ch. 282. C.A.; [1982] A.C. 1, 16, H.L.
(28) *Young* v. *Odeon Music House* [1976] 10 A.L.R. 153, 161.

CIVIL SUIT.

Dato V.L. Kandan (*S.F. Wong* with him) for the plaintiffs.

Wong Weng Kwai (*Darryl Goon* with him) for the defendants.

Cur. Adv. Vult.

Chan J.: In this judgment, I speak of various things – of copyright and censorship and on *Anton Piller* and even pirates. I shall begin with pirates.

Pirates

"'It is, it is a glorious thing, to be a Pirate King,' said W.S. Gilbert; but he was speaking of ship pirates. Today we speak of film pirates. It is not a glorious thing to be, but it is a good thing to be in for making money." – said Lord Denning M.R. in *Rank Film Ltd.* v. *Video Information Centre*[1]. Those words from the libretto of Gilbert and Sullivan's *The Pirates of Penzance* speak of ship pirates. Lord Denning M.R. spoke of film pirates. I speak today of television pirates.

There are several kinds of modern day buc-

caneers and they operate in all sorts of cunning and illicit ways. One kind is film pirates. Let Lord Denning M.R. take up the thread in his own inimitable style (the *Rank case, supra,* at pp. 403 – 404):

"…. Film pirates plunder the best and most recent cinema films. They transpose them on to magnetic tape: and then sell video cassettes on the black market.

A film pirate works like this. He gets hold of a technician in a cinema or in a ship or an aircraft – any place where cinematograph films are projected on to a screen. The pirate then bribes the technician. He pays him, say, £100. The technician then 'borrows' a film for a night. It is simple enough. Instead of putting the film into the cupboard, as he should, he puts it into his own case. He hands the celluloid film to the pirate. Overnight the pirate takes the film to his 'laboratory.' He has there a machine for transferring the film from celluloid on to magnetic tape. It only takes an hour or so. Next morning the pirate returns the film to the technician. He puts it into the cupboard. No one is any the wiser. The pirate has during the night made a 'master tape.' He uses it for making video casettes. He then sells these cassettes on the black market. There are many buyers available. A lot of people nowadays have video cassette recorders. Universities have them. Hotels have them. Private homes have them. They can use the cassette so as to reproduce the film when they like or wherever they like.

This black market makes huge inroads into the legitimate business of the film companies. They have been put to great expense in producing the best films: they have the copyright which gives them the sole and exclusive right to reproduce them. Yet here are the pirates plundering it – stealing all the best films."

From film piracy to television piracy is but only a video cassette recorder away. The next story will illustrate what I mean: It appeared in *Time* magazine of March 7, 1983, under the headline:

"Video"

"Dual Premier

"In 1879, to forestall an unauthorized American production of their latest operatta, *The Pirates of Penzance,* Gilbert and Sullivan arranged for virtually simultaneous opening nights in England and America. Now, 104 years later, Producer Joseph Papp's $12 million movie version of *Pirates* has received another premiere; on television and in theaters. On Feb. 18, Universal Pictures simultaneously showed the movie on 17 pay-per-view subscription and cable systems and opened it at 91 moviehouses around the country. It was the first time that a premiering film had also been released on television. The result was akin to the reaction of Frederic, the apprentice pirate in the operatta, upon discovering that his spinsterish nursemaid is not the ideal of female pulchritude: disappointment:

Of a potential audience of 1.2 million, only about 130,000, or 11%, opted to pay $10 to watch the show, which stars Linda Ronstadt, Kevin Kline, Angela Lansbury, George Rose and the rocker Rex Smith. Moreover, in its first weekend the movie earned a meager theater box office of $255,000, ...

Pirates was essentially a guinea pig for what some film executives see as a lucrative marketing technique of the future. By 1984 there may be as many as 3 million homes equipped for pay-per-view. That growing audience theoretically offers Hollywood the possibility of recouping the entire cost of a film in a single evening, conceivably without cutting into theatrical box-office receipts.

... Producer Papp points out that 'the audience we tried to attract through pay-per-view is people who don't go to the movies.' ...

"... But home viewers [got] something theater viewers did not ... television viewers got the chance to become living-room buccaneers by videotaping the film. Says Neuhauser [associate executive director of the Independent Theater Owners Association]: 'What can Universal do if more than 100,000 prints should be passing from home to home all over the U.S.?' "

Here in this country, our buccaneers do things somewhat differently from the Americans. They do it for the money: "It is a good thing to be in for making money". This is how the local pirates do it. They would videotape from television broadcasts, films or television series with their video cassette recorders. In the instant case, all of the broadcast videotaping were done in Hong Kong. They were taped off television shows and programmes which were being shown on television in Hong Kong. These are mostly television series – soap operas as they are often called. They are all, without exception, Chinese speaking shows; they are in Cantonese. These pirated "master tapes" would then be smuggled into Malaysia. The pirates would then make copies of them on video cassettes which they would let on hire to an insatiable viewing public – a predominantly Chinese public. Overnight hundreds of black market video cassette rental shops mushroomed throughout the country. There is a lot of money to be made and the pirates have a field day.

Television Broadcasts Limited (TVB) and Rediffusion Television Limited (RTV) are two Hong Kong companies. They are the producers of the television series and programmes which are shown on Hong Kong Television. TVB and RTV are owners of the copyright in those television films or soap operas. They have produced those films at great expense. Golden Star Video Berhad have the exclusive right from them to reproduce these films on video cassettes for distribution to their dealers or outlets for hiring out to the public.

TVB, RTV and Golden Star are the plaintiffs in this action. From investigations conducted by Golden Star, they have discovered that the defendants, Mandarin Video Holdings Sendirian Berhad have been hiring out pirated copies of their television series on the black market. They have not given permission to Mandarin to make copies of or put on video cassettes their films. Mandarin are pirates – video pirates. One of the plaintiffs' representatives went to the defendants' shop at 115 Imbi Road, Kuala Lumpur on December 7, 1982. He asked for and was given a catalogue. In it were the titles of many infringing copies of the plaintiffs' films on video cassettes. He paid the shopkeeper a fee as advance payment and he "borrowed" four of the infringing tapes.

Mandarin were engaged in offences contrary to section 15(1) of the Copyright Act 1969. The penalties are severe – a fine not exceeding $10,000 for each infringing copy or $100,000 whichever is the lower, and or imprisonment not exceeding five years. But the criminal law can be slow and cumbersome at times for it to be effective. Not so long ago in a criminal prosecution under the Copyright Act 1969 video cassettes which have been produced in evidence before a magistrate were found to have been erased. Recently, in *Public Prosecutor* v. *Chan Kam Lai*[2] Ajaib Singh J. quashed the conviction of a pirate video cassette shopkeeper for an offence contrary to section 15(1) of the Copyright Act 1969 because proceedings under the section were not instituted within six months of the seizure of infringing cassettes by the police when they raided the shop – according to the judgment, proceedings were commenced seven days after six months. [I cannot find anything in section 15(4)(b) that could support the decision. The subsection does not limit the time for bringing proceedings; all that it says is that if no proceedings under the section "are instituted within six months of the seizure" the articles seized shall be returned to the person who had possession of them when they were seized. The police in that case failed to return the seized articles; instead they produced them as evidence at the trial at Ipoh magistrate's court. Once admitted in evidence, the court trying the case has the power of disposal over the articles that were produced: subsection (2). If the court did not make an order for their disposal, then under subsection (4)(a) they are to be returned to the person who had them before they were seized. Perhaps the judge's attention was not drawn to the Privy Council case of *Kuruma* v. *The Queen*[3] in which it was held that the test to be applied, both in civil and criminal cases, in considering whether evidence is admissible is whether it is relevant to the matters in issue. If it is, it is admissible and the court is not concerned with how it was obtained].

The defendants have done great wrong to the plaintiffs. They have plundered the copyright in the plaintiffs' most recent television films. Even television films can cost a lot of money to make. The defendants stole the copyright in them and have not paid a cent for them; they do not have to bear the huge cost of producing the films. We are told by Templeman L.J. in the *Rank case* (*supra*, at p. 416) that the plaintiffs in that case were "part of an industry which may spend millions of pounds in the production and exploitation of a single film." *The Pirates of Penzance* cost the producer US$12 million to make. Pirates proliferate the market with infringing copies at a fraction of the true price. For example, music pirates do not have to pay anything to the musicians and artistes. They have no production cost to bear, no studio time to pay for. They reap huge profits without having to pay royalties. Piracy in whatever form is to be deprecated. Authors, publishers, songwriters, recording artistes and recording companies have all suffered from the plunder of the pirates.

Anton Piller

So the plaintiffs came to this court to seek recourse. They asked for an *ex parte* order – they did not want the defendants to have notice of the application; they wanted an order before the writ was even served. They wanted to take the defendants by surprise so that they could not get rid of incriminating evidence and their stock of infringing video cassettes. In a word they were asking for an *Anton Piller* order. The order is known by that name because it was in *Anton Piller KG* v. *Manufacturing Processes Ltd.*[4] that the English Court of Appeal gave their approval to such orders. "It is an innovation which has proved its worth time and time again. So long as the evidence is strong enough, it is now commonplace ..." said Lord Denning M.R. in *Rank Film Ltd.* v. *Video Information Centre, supra,* at p. 406. See also Bridge L.J., at p. 411:

"Modern technology has greatly facilitated the pirating of copyright material, especially in the form of sound recordings and films. To give effective relief to the copyright owners seeking to enforce their legal remedies against the pirates the courts have found it necessary to devise a form

of order for what may be called instant discovery granted on ex parte application. Such orders are commonly referred to as Anton Piller orders having first been approved in this court in *Anton Piller KG* v. *Manufacturing Processes Ltd.* [1976] Ch. 55."

And in the House of Lords this is what Lord Wilberforce said of *Anton Piller* orders, at p. 439:

"They are designed to deal with situations created by infringements of patents, trade marks and copyright or more correctly with acts of piracy which have become a large and profitable business in recent years. They are intended to provide a quick and efficient means of recovering infringing articles and of discovering the sources from which these articles have been supplied and the persons to whom they are distributed before those concerned have had time to destroy or conceal them. Their essence is surprise. Because they operate drastically and because they are made, necessarily, *ex parte* – i.e. before the persons affected have been heard, they are closely controlled by the court: see the judgment of Lord Denning M.R. in *Anton Piller* [1976] Ch. 55, 61. They are only granted upon clear and compelling evidence, and a number of safeguards in the interest of preserving essential rights are introduced. They are an illustration of the adaptability of equitable remedies to new situations."

And at pp. 444 – 445, Lord Fraser of Tullybelton said:

"These orders are only made when the plaintiff produces strong *prima facie* evidence of infringement of his copyright. They are made on the *ex parte* application of the plaintiff, are served on the defendants without previous notice and order the defendants to make immediate discovery of documents and to give immediate answers to interrogatories designed to find out particularly the names and addresses of their suppliers. Orders of that general nature, tending gradually to increase in stringency – see *E.M.I. Ltd.* v. *Sarwar* [1977] F.S.R. 146 – have been found effective and have been made in several reported cases in England as well as in New Zealand (apparently independently of the English development) and also in South Africa, Australia and elsewhere, apparently following the English practice."

The first reported local case is *Lian Keow Sdn. Bhd.* v. *Paramjothy*[5].

The usefulness of the *Anton Piller* order is on the element of surprise. This is so essential in cases of piracy. If the pirates have been forewarned then vital documents and articles would be lost, hidden or destroyed. It is too late to shut the stable-door when the steed is stolen.

In *E.M.I. Ltd.* v. *Pandit*[6] Templeman J. had this to say, at p. 304:

"... if the plaintiffs now seek ... relief and they serve notice on the defendant of the relief which they seek, then the horse will rapidly leave the stable, if he has not gone already, and the plaintiffs will be effectively debarred from obtaining ... relief. It also seems clear from the evidence that there have been and may well be still on the premises documents which are vital to the plaintiffs if they are to prove their case at the trial and which, more particularly and importantly, will be vital to the plaintiffs if they are to calculate and prove damages in the course of the inquiry into damages which they seek."

Later in his judgment he said, at pp. 305H – 306A:

"... if it appears that the object of the plaintiffs' litigation will be unfairly and improperly frustrated by the very giving of the notice which is normally required to protect the defendant, there must be exceptional and emergency cases in which the court can dispense with the notice and, either under power in the rules to dispense with notice or by the exercise of its inherent jurisdiction, make such a limited order, albeit ex parte, as will give the plaintiffs the relief which they would otherwise be unable to obtain. In the present case I am satisfied that, if notice were given to the defendant, that would almost certainly result in the immediate destruction of the articles and information to which the plaintiffs are entitled and which they now seek."

The decision of Templeman J. in that case was approved by the Court of Appeal in the case of *Anton Piller KG* v. *Manufacturing Processes, supra.* This is what Lord Denning M.R. said in the leading judgment; at p. 59, he set out the facts:

"... [The Plaintiffs] were about to produce a fine new frequency converter called the 'Silent Block'. They feared that M.P.L., in co-operation with the German manufacturers, would make a copy of their 'Silent Block' and ruin their market. They determined to apply to the court for an injunction to restrain M.P.L. and their directors, the defendants, from infringing their copyright or using confidential information or making copies of their machines. But they were fearful that if the defendants were given notice of this application, they would take steps to destroy documents or send them to Germany or elsewhere, so that there would be none in existence by the time that discovery was had in the action."

then he went on to say, at pp. 60 – 61:

"... the question is in what circumstances ought such an order [to] be made. If the defendant is given notice beforehand and is able to argue the pros and cons, it is warranted by [United Company of Merchants of England, Trading to the *East Indies* v. *Kynaston* (1821) 3 Bli. (o.s.) 153] in the House of Lords and by R.S.C., Ord. 29, r. 2(1) and (5). But it is a far stronger thing to make such an order *ex parte* without giving him notice. This is not covered by the Rules of the Supreme Court and must be based on the inherent jurisdiction of the court. ... So it falls to us to consider it on principle. It seems to me that such an order can be made by a judge *ex parte,* but it should only be made where it is essential that the plaintiff should have inspection so that justice can be done between the parties, and when, if the

defendant were forewarned, there is a grave danger that vital evidence will be destroyed, that papers will be burnt or lost or hidden, or taken beyond the jurisdiction, and so the ends of justice will be defeated; and when the inspection would do no real harm to the defendant or his case."

Ormrod L.J. agreed with Lord Denning M.R., and added, at pp. 61 – 62:

"The proposed order is at the extremity of this court's powers. Such orders, therefore, will rarely be made, and only when there is no alternative way of ensuring that justice is done to the applicant. There are three essential pre-conditions for the making of such an order, in my judgment. First, there must be an extremely strong *prima facie* case. Secondly, the damage, potential or actual, must be very serious for the applicant. Thirdly, there must be clear evidence that the defendants have in their possession incriminating documents or things, and that there is a real possibility that they may destroy such material before any application inter partes can be made."

In the *Rank case, supra,* Templeman L.J. said at pp. 416 – 417:

"... The evidence in this case and evidence derived from other cases demonstrate that an action against a dealer in infringing films or records copied in breach of copyright will not adequately protect the property or rights or remedies of the copyright owner if the dealer is warned of the action and is able to disperse his stock of infringing copies and conceal his suppliers, customers and confederates. The infringing copies disappear, the dealer submits to an injunction, but the infringing copies reappear and are duplicated and remain in circulation in other hands. Effective protection of copyright in these circumstances require immediate seizure of infringing copies and immediate discovery and interrogatories relating to the supply and sale of infringing copies, otherwise the dealer and his confederates can take untraceable evasive action."

A little later in his judgment, he said, at p. 418:

"... The evidence established that the plaintiffs' rights or ownership over the infringing copies could only be exercised and the plaintiffs' copyright and other rights vested in them by the Copyright Act 1956 could only be protected if the court ordered the defendants to allow the plaintiffs' representatives to enter on the defendants' premises and to seize infringing copies. If the stable door cannot be bolted, the horse must be secured. ... There was ample evidence to justify the inference that the order would fail to protect the plaintiffs unless it was both peremptory and penal, and made, served and implemented without prior notice to the defendants. If the horse is liable to be spirited away, notice of an intention to secure the horse will defeat the intention."

The plaintiffs were naturally very concerned. They were fearful that unless they obtain an *Anton Piller* order the defendants would easily remove, destroy or erase incriminating documents and articles like invoices, delivery orders, account books, names and addresses of persons who have borrowed the pirate tape, records of infringing tapes reproduced by them, and pirate video cassettes. I thought their fears were justified. This is what Whitford J. said at first instance in the *Rank case, supra,* at p. 387:

"... Recent developments in the field of audio-visual recording on tape and reproduction by way of television receivers have brought about a position in which those owning copyright in cinematograph films are finding themselves in much the same situation as owners of copyright in sound recordings have already found themselves. Pirated versions of cinematograph films are becoming increasingly available.

Copyright owners in the sound recording field seeking to protect their interests found themselves initially forced to bring proceedings against retailers frequently operating in street markets. On the proceedings being served it was a common experience to find that stocks of alleged infringing records or tapes had mysteriously disappeared overnight, as had any documents or records which might lead to the source of supply. So far as plaintiffs are concerned, the closing down of individual retail outlet, although it is no doubt in some respects beneficial, is unlikely to prove effective in relief against the injury in respect of which complaint is made.

It was against this background that the plaintiff in *E.M.I. Ltd.* v. *Pandit* [1975] 1 W.L.R. 302 secured an *ex parte* order permitting the plaintiffs by their solicitors to enter the defendant's premises to inspect any documents or articles relevant to an alleged infringement of copyright in sound recordings and to remove the relevant material into custody. Orders of this kind have subsequently been made in a number of cases and they are now generally referred to as *Anton Piller* orders, as it was in *Anton Piller K.G.* v. *Manufacturing Processes Ltd.* [1976] Ch. 55, that the Court of Appeal first gave the seal of their approval to such orders.

It is right to say that this is a form of order which was then regarded at least by Ormrod L.J., as being at the extremity of the court's powers. If Omrod L.J.'s expectations that such orders would rarely be made have not been entirely fulfilled, this is no doubt in part due to the large increase in the sales of pirated works and, in part, to the efficacy of the *Anton Piller* order in bringing proceedings of this kind, in many cases, to a speedy conclusion."

Despite Ormrod L.J.'s reservations that such orders would rarely be made, the *Anton Piller* order has now become "commonplace". "So useful are these orders that they are in daily use – not only in cases of infringement of copyright, but also in passing off cases, and other cases." – per Lord Denning M.R. in *Ex Parte Island Records Ltd.*[7] This is "due to the large increase in the sales of pirated works and ... to the efficacy of the Anton Piller order in bringing [such] proceedings ... to a speedy conclusion." In *International Electronics Ltd.* v. *Weigh Data Ltd.*[8] Graham J. made the following observations:

"I would ... like to confirm as a Patent Judge that justice in many industrial property cases, such as those involving patents, trade marks, copyright and confidential information, can often only satisfactorily be dispensed if, as the Master of the Rolls urged in the *Rank case, Anton Piller* orders are made. There are many unscrupulous pirates in these fields and *Anton Piller* orders or something equivalent are necessary to prevent offending parties disposing of vital evidence before normal discovery is obtained. Such orders must of course be granted with great care, and hedged with all proper restrictions so as to avoid oppression. They have however in my experience worked well in practice and I have no knowledge of any oppressions having been caused. They undoubtedly reduce the time and cost involved in trying such cases and prevent evasion of justice by unscrupulous parties."

Sitting as a judge in the Commercial Division where *Anton Piller* orders are commonplace, I can say that I share those views. They apply with equal force to this country. Pirates are men without scruples. These are not honest men that we speak of. These are thieves who stole from the plaintiffs the copyright in their best and most recent television films. The plaintiffs were extremely anxious. They were fearful that if the defendants were forewarned, important documents would be destroyed or removed. Infringing video cassettes would disappear only to reappear again elsewhere. I was satisfied, on the evidence, that there was a strong *prima facie* case against the defendants that they have been dealing in illicit films and that the plaintiffs have satisfied the requirements for the making of an *Anton Piller* order. I was satisfied that the defendants were dealing with pirated video cassettes which infringed the plaintiffs' rights.

In *Universal City Studio Inc.* v. *Mukhtar & Sons Ltd.*[9], it was held by Templeman J. in that case that although it was impossible to decide whether the plaintiffs' fears were justified, there was a possibility that their fears would be realised if litigation took its normal course.

In *Yousif* v. *Salama*[10], Lord Denning M.R. had this to say, at pp. 1541 – 1542:

"The plaintiff, who was resident in the Middle East, says that he made an agreement with the first defendant. Certain goods were to be purchased in England and dispatched to the Middle East. They were then to be re-sold there. In respect of those transactions, the profit was to be divided between the plaintiff and the second defendant, a company controlled by the first defendant ...

"... in March 1980 the plaintiff went with the first defendant to the defendant company's office to go through the accounts. Two files were produced containing the various accounts. They showed sums due to the plaintiff. Also a desk diary.

The plaintiff, being very anxious about the matter, brought proceedings in the court for the sum due to him. On April 16, 1980, he issued a writ for that purpose. The total sum claimed was £14,000-odd. The writ was served. The solicitors for the defendants wrote to the plaintiff's solicitors saying that they were going to defend the claim strenuously.

The plaintiff then became very anxious about the file and the desk diary he had seen which contained details of the transactions. He became fearful that the first defendant would destroy those documents before the actual hearing of the case. On May 6, 1980, the plaintiff applied for an *Anton Piller* order. He did not notify the defendant that he was making the application: because he was afraid the defendant would destroy the documents if he were notified. The plaintiff asked that he should be granted an *Anton Piller* order to enable him to go to the defendant company's offices and inspect the documents before the first defendant had an opportunity to destroy them.

In many cases such an order would not be granted. But in this case there is evidence (if it is accepted) which shows the first defendant to be untrustworthy. The plaintiff has a legitimate fear that the documents will be destroyed. In the circumstances, it seems to me that it would be proper to make an *Anton Piller* order ..."

In that case, Lord Denning M.R. said that there was evidence that the defendant was untrustworthy. So the Court of Appeal held (Donaldson L.J. dissenting) that the plaintiff's fears that the documents would be destroyed or hidden were legitimate. Lord Denning M.R. said, at p. 1542:

"There is a genuine fear that, if the plaintiff waits till after the application is heard, the first defendant may destroy the documents before the date of the hearing. That is the sort of danger which the *Anton Piller* order is designed to prevent."

Brightman L.J. agreed with Lord Denning M.R. and said, at p. 1544:

"In my view, the order sought in this case is justified if, but only if, there is prima facie evidence that essential documents are at risk. If essential documents are at risk, then it seems to me that this court ought to permit the plaintiff to take such steps as are necessary to preserve them.

So there are two questions to be asked. First, are the documents sought to be seized essential to the plaintiff's case? If so, are such documents at serious risk? Might they be dishonestly destroyed?"

Although Donaldson L.J. dissented from Lord Denning M.R. and Brightman L.J. on the facts, he stated the principle in very much the same way. He said, at p. 1543:

"The essential feature of those cases, as I understand them, is that there is a very clear *prima facie* case leading the

court to fear that the defendant will conceal or destroy essential evidence in the grossest possible contempt of the court and – and this is an important second limb – that should he do so the whole processes of justice will be frustrated because the plaintiff will be left without any evidence to enable him to put forward his claim. In that limited class of case I, for my part, think that the *Anton Piller* order is absolutely right. No court can stand by and see the processes of justice totally frustrated by a defendant in contempt of its order. But I cannot find anything in this case which brings it within that category. I regard the evidence of an intention to destroy the documentation as flimsy in the extreme. It is based upon an allegation of forgery in the indorsement of a cheque. This has nothing whatever to do with the destruction of documents which the plaintiff says that he fears."

In the instant case, the defendants are pirates. They are thieves and I daresay untrustworthy. They are unscrupulous people. When dealing with them this court has to be especially wary. Was there a genuine fear in the instant case? Were essential documents and articles at risk? I was satisfied that the plaintiffs have a legitimate fear that important documents and infringing video cassettes would be removed or hidden. I accepted the view of the plaintiffs that there was a real possibility of that happening. So I granted the order that was sought. It is an *Anton Piller* order. It was made *ex parte* and it also carries with it an injunction enjoining the defendants from doing various acts which would be infringing acts. But the order for an injunction is only temporary. It stood until the hearing of an *inter partes* application for it to be continued. This application is now being opposed strenuously by the defendants. After five days of argument, I reserved judgment. I shall deal with the defendants' objections shortly. But right now, I have to deal with a fresh point that was raised subsequently. When drafting this judgment, the thought occurred to me that the judgment of the House of Lords in the *Rank case* on self-incrimination may apply to the present case. I intimated to counsel that I would like to hear argument on this. On April 26, 1983, I had the benefit of full argument from counsel.

Dato Kandan pointed out that there was no claim to privilege on the ground of self-incrimination until now. He asked if this is still possible at such a late stage. Mr Wong, however, countered that privilege could be claimed at any time. He referred to the *Rank case, supra,* particularly to the judgment of Bridges L.J. at p. 412:

"The claim to privilege on the ground of self-incrimination is advanced without particularity in an affidavit filed by the second defendant. On behalf of the other defendants it is advanced only through the mouth of counsel. This is unsatisfactory. But it would be even more unsatisfactory to dispose of the matter simply on the ground that the privilege is insufficiently claimed or there are insufficient grounds for claiming it."

I am of the view that the claim to privilege against self-incrimination could be made at any time provided that the defendants have not replied to the order. I am told that this has not been done yet. Once the defendants have supplied to the plaintiffs the particulars requested in the order then it would be too late to claim the privilege. What has been done cannot be undone: see *Kuruma* v. *The Queen (supra)* in which it was held that if the evidence is relevant to the matters in issue it is admissible and the court is not concerned with how it was obtained.

Now, the question is, does the *Rank case* apply. It was applied in Hong Kong: *Lincoln International Ltd.* v. *Eagleton Direct Exports Ltd.*[11] The privilege itself is well established in English law; see the *Rank cases, supra,* per Lord Denning M.R. at p. 407:

"... The privilege against self-incrimination is so deeply imbedded in our law that it cannot be uprooted. The common law was stated with the authority of all the 12 judges in 1847 in *Reg.* v. *Garbett* (1847) 2 Car. and Kir. 474: and the courts of equity did the same, it being declared emphatically by Lord Eldon L.C. in *Paxton* v. *Douglas* (1812) 19 Ves. 225, 226. It has been treated as a settled principle both by Parliament in section 14 of the Civil Evidence Act 1968 and by me in *In re Westinghouse Electric Corpn. Uranium Contract Litigation M.D.L. Docket No. 235 (No. 2)* [1978] A.C. 547, 563 – 564 and approved in the House of Lords by Lord Wilberforce at p. 612, Viscount Dilhorne at p. 627 and Lord Fraser at p. 647."

by Templeman L.J. at p. 418:

"By the common law, summarised by Bowen L.J. in *Redfern* v. *Redfern* [1891] P. 139, 147, impliedly accepted by Parliament in section 16(1)(a) of the Civil Evidence Act 1968 and reiterated by this court and approved by the House of Lords in the *Westinghouse Uranium Contract case* [1978] A.C. 547, in any legal proceedings a person, whether a party to the proceedings or not, cannot be compelled to answer any question or produce any document or thing if to do so would tend to expose him to proceedings for an offence."

and by Lord Fraser at p. 446:

"... The privilege itself is well established in English law. It is impliedly recognised by section 14(1) of the Civil Evidence Act 1968, and authority for its existence is to be found in *Triplex Safety Glass Co. Ltd.* v. *Lancegaye Safety Glass* (1934) Ltd. [1939] 2 K.B. 395 and *In re Westinghouse Electric Corporation Uranium Contract Litigation M.D.L. Docket No. 235 (No. 2)* [1978] A.C. 547."

So it was held in the *Rank case* that the defendants were entitled to rely on the privilege against self-incrimination by discovery or answering interrogatories as there was in the circumstances of that case a real and appreciable risk of criminal proceedings for conspiracy to defraud being taken against them. But it was also held that the risk of prosecution under section 21 of the English Copyright Act 1956 is trivial and remote. Lord Wilberforce said, at p. 441:

"The criminal offences created by section 21 cover almost precisely the same ground as the [basis] for civil liability under the Copyright Act 1956. I would be reluctant to hold that in civil proceedings for infringement based on specified acts the defendants could claim privilege against discovery on the ground that those same acts establish a possible liability for a petty offence. In practice, as one would suppose, section 21 is very rarely invoked: only one case came to our knowledge, namely of a prosecution in 1913 under the Copyright Act 1911, and potential liability under it might well be disregarded as totally insubstantial. The same argument would apply as regards conspiracy to breach it.

However, it is only too clear (and I deliberately use the language of reluctance) that supply of the information and production of the documents sought would tend to expose the respondents to a charge of conspiracy to defraud. In the very nature of this activity, a number of persons are certain to be involved in it – in printing the master tapes, copying from the master tapes, seeking and accepting orders, and distributing the illicit copies. A charge of conspiracy to defraud, so far from being, as it sometimes is, a contrived addition to other charges, is here an appropriate and exact description of what is being done. So far from it being contrived, fanciful, or imagined, it is the charge on which Mr. Dawson, who appears on the existing evidence to be closely connected with Mr. Lee and Ms. Gomberg, is to stand trial. It cannot be said that charges under this head would be nothing but charges under section 21 of the Act of 1956 under another name. An essential ingredient in them is dishonesty, which may exist in cases brought under section 21, but which may not. The much heavier penalties also make it more likely that charges would be brought of conspiracy to defraud. Unless some escape can be devised from this conclusion, the privilege must inevitably attach."

and Lord Fraser said, at p. 445:

"The risk of prosecution under the Theft Act may, I think, be disregarded as remote, because that Act applies to theft of "property" which is defined in a way that does not appear to include copyright, but only, so far as this appeal is concerned, to the physical objects such as tapes and cassettes which are of small value by themselves. The risk of prosecution under section 21 of the Copyright Act 1956 is theoretically greater because acts which are infringements of copyright, including the making of unauthorised copies (section 13(5)) and knowingly importing, or selling infringing copies (section 16(2) and (3)(a)) are very likely also to be offences under section 21(1). But the offences created by section 21 are only ancillary remedies for breach of copyright, as appears from the cross-heading to Part III of the Act, and they are treated as comparatively trivial with a maximum penalty (as amended) of £50. It would, in my opinion, be unreasonable to allow the possibility of incrimination of such offences to obstruct disclosure of information which would be of much more value to the owners of the infringed copyright than any protection they obtain from section 21.

But conspiracy to defraud is a different matter. It is a serious offence. The risk of those who deal in or manufacture illicit films being prosecuted for it is by no means remote or fanciful."

The upshot is that the privilege cannot be invoked where the risk of criminal prosecution is remote or where the offences are trivial in nature. In other words, there must be a real and appreciable risk, as distinct from a remote or insubstantial risk, of proceedings being taken against the defendants: see the tests suggested by Lord Denning M.R. In *Re Westinghouse Uranium Contract*[12].

Nevertheless the *Rank case* had given rise to grave concern. "It may seem to be a strange paradox" observed Lord Wilberforce (at p. 439 in the *Rank case*) "that the worse, i.e. the more criminal their activities can be made to appear the less effective is the civil remedy that can be granted but that, *prima facie,* is what the privilege achieves." And Lord Fraser remarked (at p. 445), "If the [claim to privilege] is well founded the usefulness of the *Anton Piller* type of order will be much reduced if not practically destroyed." Lord Russell appealed for the intervention of the legislature (at p. 448):

"Inasmuch as the application of the privilege in question can go a long way in this and other analogous fields to deprive the owner of his just rights to the protection of his property I would welcome legislation somewhat on the lines of section 31 of the Theft Act 1968: the aim of such legislation should be to remove the privilege while at the same time preventing the use in criminal proceedings of statements which otherwise have been privileged."

Graham J. in *International Electronics Ltd.* v. *Weigh Data Ltd., supra* (at p. 427), sounded a call for parliamentary intervention. He spoke of the *Rank case* (then on appeal to the House of Lords) thus:

"If the view of the legal position expressed by the majority of the Court of Appeal is confirmed by the House of Lords, I sincerely hope it may be possible to enact as soon as possible amending legislation to restore this effective weapon to the armoury of the Judges dispensing justice in these important fields."

The call was heard and the law as laid down in the *Rank case* against self-incrimination was with-

drawn by section 72 of the Supreme Court Act 1981. According to subsection (2), the privilege cannot be claimed in the following civil proceedings in the High Court:

(a) proceedings for infringement of rights pertaining to any intellectual property or for passing off;

(b) proceedings brought to obtain disclosure of information relating to any infringement of such rights or to any passing off; and

(c) proceedings brought to prevent any apprehended infringement of such rights or any apprehended passing off.

That is the present state of the law in England. In this country, the privilege is withdrawn by section 132 of the Evidence Act 1950. The Indian position is the same as ours (they have similar provisions in section 132 of their Evidence Act), except that clause (3) Art. 20 of the Indian Constitution still accords protection to the accused person. It is in these terms: "No person accused of any offence shall be compelled to be a witness against himself".

Section 132 of the Evidence Act 1950 says:

"(1) A witness shall not be excused from answering any question as to any matter relevant to the matter in issue in any suit, or in any civil or criminal proceedings, upon the ground that the answer to that question will criminate or may tend directly or indirectly to criminate, him, or that it will expose, or tend directly or indirectly to expose, the witness to a penalty or forfeiture of any kind, or that it will establish or tend to establish that he owes a debt or is otherwise subject to a civil suit at the instance of the Government of Malaysia or of any State or of any other person.

(2) No answer which a witness shall be compelled by the court to give shall subject him to any arrest or prosecution, or be proved against him in any criminal proceeding, except a prosecution for giving false evidence by that answer.

(3) Before compelling a witness to answer a question to which will criminate or may tend directly or indirectly to criminate him the court shall explain to the witness the purport of subsection (2)."

As I have said a moment ago, the privilege against self-incrimination has been withdrawn in this country. In order to understand the effect of section 132 one has to go back to first principles. What is the rule against self-incrimination all about at common law? In *Triplex Safety Glass Co. Ltd.* v. *Lancegaye Safety Glass (1934) Ltd.*[13], du Parcq L.J. delivering the judgment of the Court of Appeal, of which Sir Wilfrid Greene M.R. was a member, put the common law position thus:

"The law is well settled. It is a general rule that 'no one is bound to criminate himself,' in the sense that he is not to be compelled to say anything *which 'may tend to bring him into the peril and possibility of being convicted as a criminal.':* per *Field J. in Lamb* v. *Munster* (1882) 10 Q.B.D. 110, 111." (emphasis added)

Lord Denning M.R. summarised the position accurately when he said, at p. 563, in the *Westinghouse Uranium Contract case, supra:*

"Now I come to ... the question of privilege. We have a rule here against self-incrimination. The common law has for centuries held that a person is not bound to answer a question *which may render him liable to punishment, penalty or forfeiture.* In the United States under the Fifth Amendment an individual (not a company) is entitled to a privilege by which he is not bound to answer questions by which he may incriminate himself. (emphasis added).

"Take [the] English position. We discussed it in the recent case of *Comet Products U.K. Ltd.* v. *Hawkex Plastics Ltd.* [1971] 2 Q.B. 67."

I quoted at p. 73 Bowen L.J. as saying in *Redfern* v. *Redfern*[14]:

'It is one of the inveterate principles of English law that a party cannot be compelled to discover that, *which,* if answered, *would tend to subject him to any punishment, penalty, forfeiture,* ... 'no one is bound to criminate himself'.' (emphasis added)

"That privilege prevailed in England until an inquiry by the Law Reform Committee, 16th Report in 1967 (Cmnd. 3472). They recommended that the privilege in regard to forfeiture should be abolished. It had been upheld in *Earl of Mexborough* v. *Whitewood Urban District Council* [1897] 2 Q.B. 111. It was expressly abolished by the Civil Evidence Act 1968, section 16(1)(a).

But the privilege in respect of penalties was not abolished. It was retained by section 14. It says:

'(1) The right of a person in any legal proceedings other than criminal proceedings to refuse to answer any question or produce any document or things if to do so would tend to expose that person to proceedings for an offence or for the recovery of a penalty – (a) shall apply only as regards criminal offences under the law of any part of the United Kingdom and penalties provided for by such law; ...' "

He went on to say, at p. 564:

"There is, after all, good reason for retaining [the privilege] – the same reason as lay behind its introduction centuries ago. No person should be compelled to expose himself to pains or penalties out of his mouth. If he is to be penalised for wrongdoing, it should be proved against him by those who accuse him."

So there we have the real reason for the privilege. It is that no one is bound to say anything which may bring him into the peril and possibility of being punished or penalised for wrongdoing. So if there was no danger of liability to punishment or

penalty the privilege would go. "If, however, circumstances arose" continued Lord Denning M.R. at p. 565, "so as to show that there is 'no real or appreciable' danger to the Rio Tinto company of being fined or exposed to a penalty, the privilege would be lost: see *Reg.* v. *Boyes*[15] So if the European Commission said they were not going to take any proceedings, there would not be any risk and the privilege would go."

Section 132(2) of the Evidence Act 1950 does just that. The subsection says:

"(2) No answer which a witness shall be compelled by the court to give shall subject him to any arrest or prosecution, or be proved against him in any criminal proceeding, except a prosecution for giving false evidence by that answer."

The first limb of this subsection takes away the risk of arrest or prosecution and, therefore, the privilege goes (this provision is not found in the English Theft Act 1968, section 31 nor in the Supreme Court Act 1981, section 72). It also at the same time (second limb) prevents the use in criminal proceedings of evidence or statements which otherwise would have been privileged.

Apart from subsection (2), subsection (1) by itself is wide enough to withdraw or remove altogether the privilege against self-incrimination. Just as section 31(1) of the English Theft Act 1968 is sufficient to withdraw the privilege, not altogether, as in this country, but limited to offences under the Act. That section broadly provides that a person shall not be excused from answering questions or complying with any order in civil proceedings relating to property on the ground that to do so might incriminate him of an offence under the Act (compare this with our own subsection (1)) but no statement or admission made in compliance with such an order is to be admissible in evidence against him (just as in our own subsection (2) second limb). *C.B.S. United Kingdom Ltd.* v. *Lambert*[16] is a case in point. (It was decided at first instance before the coming into force of the Supreme Court Act 1981). There it was held by the Court of Appeal that section 31 of the Theft Act 1968 has withdrawn the privilege in that case. Lawton L.J. in giving the judgment of the court, said at pp. 132 – 133:

"We were informed that Goulding J., when he heard this application at first instance, refused to order ... discovery ... We were told that he was concerned that the defendant Steven Lambert might be obliged by an order for discovery to incriminate himself, having regard to the fact that he had been charged with handling stolen property. The learned judge's attention was not invited to section 31 of the Theft Act 1968, which provides that a person shall not be excused from answering questions in civil proceedings such as these on the ground that to do so might incriminate him of an offence under the Act. In our judgment, the judge's concern was misplaced. The possibility of self-incrimination on the facts of this case is no bar to ordering discovery."

Similarly, section 72(1) of the English Supreme Court Act 1981 has withdrawn the privilege, albeit limited to those civil proceedings which are mentioned in subsection (2) of the Act. Sub-section (3) provides that:

"... no statement or admission made by a person –

(a) in answering a question put to him in any proceedings to which subsection (1) applies; or

(b) in complying with any order made in any such proceedings,

shall, in proceedings for any related offence or for the recovery of any related penalty, be admissible in evidence against that person ..."

At this point, it is convenient to return to the words, which I have quoted earlier, of Lord Russell in the *Rank case* (p. 448):

"I would welcome legislation somewhat on the lines of section 31 of the Theft Act 1968: the aim of such legislation should be to remove the privilege while at the same time preventing the use in criminal proceedings of statements which would otherwise have been privileged."

Section 132 of the Evidence Act 1950, and in a limited way section 72 of the English Supreme Court Act 1981 have done exactly that: they have removed the privilege (section 132(1), section 72(1) and (2)) while at the same time prevented the use in criminal proceedings of statements which otherwise would be privileged (section 132(2) second limb, section 72(3)).

I do not know if I should comment on *Chye Ah San* v. *R.*[17] but since Mr. Wong has cited it, perhaps I should say a few words. He referred to a passage in the judgment of Spenser Wilkinson J. which says, at p. 220:

"On this point I think that the difference between the English law and local law on the subject of incriminating statements must be kept in mind. In England a witness in a Court of Law is not bound to answer questions which may tend to criminate him. In this country, however, the maxim is enforced in a different way, because under section 132 of the Evidence Ordinance a witness is bound to answer all questions even though they may tend to

criminate him, but if he is forced to answer such questions then no proceedings can be taken against him based upon his answers except proceedings for perjury."

That *dictum* is pregnant with half-truths and misconceptions. I think Spenser Wilkinson J. did not appreciate the true value of the maxim. I have tried to explain it in my analysis of the law on the privilege. To recapitulate, the English position is that as was stated by Field J. in *Lamb* v. *Munster*[18]

"... the principle of our law right or wrong is that a man shall not be compelled to say anything which criminates himself. Such is the language in which the maxim is expressed. The words 'criminate himself' may have several meanings, but my interpretation of them is 'may tend to bring him into the peril and possibility of being convicted as a criminal.'"

This prompted du Parcq L.J. to say in the *Triplex Safety Glass case, supra,* 403:

"It is a general rule that 'no one is bound to criminate himself,' in the sense that he is not to be compelled to say anything which 'may tend to bring him into the peril and possibility of being convicted as a criminal.': per Field J. in *Lamb* v. *Munster* (1882) 10 Q.B.D. 110, 111."

Bowen L.J. confirmed that principle in *Redfern* v. *Redfern (supra)* at page 147 of the case:

"It is one of the inveterate principles of English law that a party cannot be compelled to discover that which, if answered, would tend to subject him to any punishment, penalty, forfeiture, ... 'no one is bound to criminate himself'."

This led Lord Denning M.R. to state in the *Westinghouse Uranium Contract case* (p. 563):

"The common law has for centuries held that a person is not bound to answer a question which may render him liable to punishment, penalty or forfeiture."

Spenser Wilkinson J.'s view that the maxim is enforced in a different way in this country is erroneous. Section 132(1) has already withdrawn or removed the privilege. It follows that the privilege can no longer be "enforced" or invoked. It is not there anymore. Also by section 132(2) first limb, there would no longer be any risk of arrest or prosecution, so the privilege is lost. There is no longer any question of "enforcing" or invoking the privilege. It has gone.

Mr. Wong has also urged on behalf of the defendants that the word "witness" in section 132 does not apply to a party – a party is not a witness. With respect, that cannot be right. Although a witness may not be a party to proceedings, the converse is not true. A party to proceedings or for that matter, even an accused person, can be a witness if he gives evidence. The meaning to be attached to the words "to be a witness" as used in Art. 20(3) of the Indian Constitution was considered in *M.P. Sharma* v. *Satish Chandra*[19] Art. 20(3) says:

"No person accused of any offence shall be compelled *to be a witness* against himself."

The case was heard by all eight judges who constituted the full bench at that time. Jagannadhadas J. who gave the judgment of the court said at p. 1087:

"The phrase used in Art. 20(3) is 'to be a witness'. A person can 'be a witness' not merely by giving oral evidence but also by producing documents or making intelligible gestures as in the case of a dumb witness (see section 119 of the Evidence Act) or the like. 'To be a witness' is nothing more than 'to furnish evidence', and such evidence can be furnished through the lips or by production of a thing or of a document or in other modes."

Das Gupta J. in *the State of Bombay* v. *Kathi Kalu*[20] explained the meaning further:

"To a person not overburdened with technical learning, the giving of evidence, would appear to be the real function of a witness. Indeed English literature is replete with instances of the use of the word 'witness' as meaning 'evidence.' To give one example; Shakespeare's Horatio speaking to Hamlet says:–

'Season your admiration for a while with an attent ear, till I may deliver, Upon the witness of these gentlemen, This marvel to you' (Hamlet, Act I, Scene, II).

There can be no doubt that to the ordinary user of English words, the word 'witness' is always associated with evidence, so that to say that to be a witness is to furnish evidence is really to keep to the natural meaning of the words."

In my judgment, a witness is a person who gives or "furnishes" evidence. If a person gives or is compelled by a court order (as in this case) to give evidence then he is a witness. It does not matter if he is a party or any other person. In the *Westinghouse Uranium Contract* case, the people and the companies concerned in the case were not parties to the litigation then pending in the United States. The court in the United States issued letters rogatory to the High Court in London requesting it to order two English companies to produce documents and certain named individuals to appear before a U.S. Consular officer in London

to give evidence as witnesses. The point which I wish to make is this – those named individuals and the two English companies were called "witnesses" although at the time they were only under compulsion by court order to give evidence and to produce documents. They have not given evidence or produced documents yet. Roskill L.J. described them as "potential witnesses" (at p. 566) and throughout the judgments in the Court of Appeal and in the House of Lords they were referred to as "witnesses". As things turned out, none of them ever became witnesses at all, that is, in the sense of "furnishing evidence", because their claim to privilege against self-incrimination was upheld by the Court of Appeal and the House of Lords.

There remains only a loose end to tie up to complete the picture on *Anton Piller* in the present case. Section 132(3) says:

"(3) Before compelling a witness to answer a question the answer to which will criminate or may tend directly or indirectly to criminate him the court shall explain to the witness the purport of subsection (2).

In view of this subsection, the *Anton Piller* order has to be modified (in this instance, paragraph 2(b) of the order) to carry a statement in terms of subsection (2), that is to say, the defendants must be informed that the answers given by them in response to the order will not subject them to the risk of arrest or prosecution and that their evidence will not be used in any criminal proceedings, except a prosecution for giving false evidence by their answers. I so order.

Censorship

I turn now to the other objections of Mr. Wong. He submitted that because the plaintiffs have committed offences contrary to section 15(1) of the Films (Censorship) Act 1952, as amended, they have lost their copyright to the films.

By section 5(1) of the Act, "The owner of *any film* produced in Malaysia shall within fourteen days after the completion of the production deposit the film in a warehouse approved for the purpose" by the Board of Film Censors. The penalty for non-compliance is a fine of up to $10,000. By section 6(1) *"No film nor any part thereof* shall on importation be removed from customs control without a permit from the Board". Subsection (2) provides that any film that is removed from customs control with a permit from the Board shall forthwith be deposited by the importer in a warehouse which has been approved by the Minister for the deposit or storage of films for the purpose of censorship. The penalty for non-compliance is a fine of up to $10,000.

It is clear then beyond a peradventure that the Act applies to all films whether locally produced (section 5) or imported (section 6) unless they are exempted by section 25 of the Act. In the case of imported films, section 6 shall not apply to any of them that "has been authorised for exhibition in Malaysia and in respect of which a certificate has been issued under section 9(2) or 9A(2)": section 6(4).

The only part of section 25 which is relevant to the present case and which is relied on by Dato Kandan for the plaintiffs is section 25(1)(d) which is as follows:

"25(1) This Act shall not apply to –

(d) any film, not being obscene or lewd, which is in the possession of any person or of his agent and is intended for his own private use and not for the purpose of sale, hire, distribution, public exhibition or circulation so long as the film remains in such possession."

I cannot see how this subsection can help the plaintiffs at all. I accept the fact that none of the films concerned in this case was pornographic in nature. But they were brought into this country by Golden Star for "distribution" to their dealers or outlets so that they could in turn "hire" them out to a large viewing public in the country. The possession of films which are not pornographic will only exempt a person from the Act if the films were meant for the person's own private use and as long as the films remained in his possession. If the films were meant for sale, hire, distribution, public exhibition or circulation, then there is no exemption and the Act applies to all such films. Since Golden Star intended the films for "distribution" and "hire" they could not claim to be exempted from the Act under section 25(1)(d).

As I have just said, all films whether locally produced or imported are caught by the Act unless they can be exempted from it by section 25. It follows, therefore, that all the twenty-two titles concerned in the instant case were caught by the Act. Mr. Wong said that Golden Star have committed offences contrary to section 15(1) of the Act. The subsection is as follows:

"15(1) Any person who exhibits, sells, hires or distributes

or causes to be exhibited, sold, hired or distributed any film –

(a) in respect of which a certificate has not been issued under section 9(2) or 9A(2);

(b) in respect of which the certificate issued under section 9(2) or A(2) has ceased to be valid under section 13 or 14;

(c) which, since the certificate was issued in respect thereof, has been altered or tampered with in any way; or

(d) in breach of a condition imposed under section 25(2),

shall be guilty of an offence and shall, on conviction, be liable to a fine not exceeding ten thousand ringgit."

Did Golden Star "distribute" the films? I think they did. They have admitted distribution of the films to their dealers and outlets before any section 9(2) or 9A(2) certificates were issued to them. Did they cause the films to be "hired" out to the public through their dealers or outlets? Again by their own admission, I think they did. They have distributed the films to their dealers and outlets with full knowledge that these films would be hired out to members of the public. Unless they could produce the certificates issued under section 9(2) or 9A(2), they would have contravened section 15(1)(a) of the Act.

Dato Kandan argued that they have not exhibited the films. He pointed out that only those who intend to exhibit their films need apply for the certificates: see section 8(1). The short answer to that is in section 15(1)(a) itself. That subsection not only makes it an offence to exhibit or cause to be exhibited any film in which a section 9(2) or 9A(2) certificate has not been issued, it also makes it as much an offence to sell or hire or distribute or to cause to be sold or hired or distributed any film which has no such certificate. There appears to be no defence for Golden Star unless they can produce the certificates. Therefore, Dato Kandan's further submission on section 12(2) of the Act would not avail them. However, since counsel had alluded to the section, I shall state my views on it. Section 12 is as follows:

"12.(1) No film shall be exhibited unless it has been authorized by the Board for exhibition and a certificate in respect thereof has been issued under section 9(2) or 9A(2).

(2) A film shall be deemed to be exhibited –

(a) when it is projected, otherwise than during and for the purposes of production or for the purpose of censorship, in the presence of eight persons or more (including the operator of the projector);

(b) if it is exhibited for the purpose of gain or reward;

(c) at the time and place at which it is advertised to be exhibited, unless the contrary is provided."

Counsel had argued that since they have not exhibited the films they were not required to have the certificates. He said that according to section 12(2)(a) a film is only deemed to be exhibited if it is shown to eight or more persons. Since the films were shown in homes on television sets, and since the average household size in this country is less than eight persons, the films could not be deemed to have been exhibited. The average household size in this country is 5.63 persons in 1970 and based on projection 5.41 in 1975: see *Population Trends and Planning in Malaysia*, p. 72 (a paper presented at the United Nations World Population Conference, Bucharest, 1974).

What counsel failed to appreciate is that section 15(1)(a) not only makes it an offence to exhibit or to cause to be exhibited a film without a censorship certificate, it also makes it an offence to sell, hire or distribute any film without a certificate. It is also as much an offence to cause to be sold, hired or distributed any film without a certificate. Exhibition of a film without a certificate is only one of several other offences in the section. It is not the only offence. However, it is correct to say that if one does not intend to exhibit a film one does not need a section 9(2) or 9A(2) certificate. But without such certificate, one cannot sell, hire or distribute the film without committing an offence under section 15(1)(a) of the Act. One can have the film for one's own private use only; the film is not to be sold, hired, distributed, publicly exhibited or circulated; section 25(1)(d).

Copyright

Would what I have just said affect the plaintiffs' claim to copyright in the films? Mr. Wong said that since they have contravened the law on censorship the plaintiffs could not come to this court to have their rights enforced. He relied on *Victorian Daylesford Syndicate* v. *Dott*[21] and *Anderson Ltd.* v. *Daniel*[22]. *Victorian* v. *Dott* is a moneylender's case. There it was held that a money-lender who has not registered his name under the Money-lenders Act 1900 cannot make any valid agreement in the course of his business as a money-lender with respect to the advance and repayment of money or take any security in the course of his business as a money-lender. In *Anderson Ltd.* v. *Daniel*, it was held that a vendor of fertiliser could not sue for the price of fertiliser

supplied because the sale was illegal in that he had committed an offence under section 6(1) of the Fertilisers and Feeding Stuffs Act 1906. That subsection requires the vendor to give an invoice to the purchaser stating the percentage of certain chemical substances contained in the fertilisers.

In *St. John Shipping Corpn.* v. *Joseph Rank Ltd.*[23] a ship *St. John* was overloaded so that its load line was submerged. The load line was still submerged when the ship arrived at its destination in the United Kingdom and the master was prosecuted for an offence under sections 44 and 57 of the Merchant Shipping (Safety and Load Line Conventions) Act 1932, and convicted and fined £1,200. When sued for the balance due for freight, the defendants contended that the shipowners were not entitled to recover as they have performed the charter in an illegal manner. Devlin J. said at p. 280:

"The defendants' case in law is that since the plaintiffs performed the contract of carriage, evidenced by the bill of lading, in such a way as to infringe the Act of 1932, they committed an illegality which prevents them from enforcing the contract at all, the defendants say they were not obliged to pay any freight, and so cannot be sued for the unpaid balance. If this is right, and if all the consignees had exerted to the full their legal powers, the effective penalty for the plaintiffs' misdeed would have been the loss of the whole freight of more than £50,000."

He went on to say at pp. 281 – 282:

"The application of this principle to a case such as this is bound to lead to startling results. Mr. Wilmers does not seek to avert his gaze from the wide consequences. A shipowner who accidentally overloads by a fraction of an inch will not be able to recover from any of the shippers or consignees a penny of the freight. There are numerous other illegalities which a ship might commit in the course of the voyage which would have the same effect; Mr. Roskill has referred me by way of example to section 24 of the Merchant Shipping (Safety Conventions) Act, 1949, which makes it an offence to send a ship to sea laden with grain if all necessary and reasonable precautions have not been taken to prevent the grain from shifting. He has referred me also the detailed regulations for the carriage of timber – similar in character to regulations under the Factories Act – which must be complied with if an offence is not to be committed under section 61 of the Act of 1932. If Mr. Wilmers is right, the consequences to shipowners of a breach of the Act of 1932 would be as serious as if owners of factories were unable to recover from their customers the cost of any articles manufactured in a factory which did not in all respects comply with the Acts. Carriers by land are in no better position; again Mr. Wilmers does not shrink from saying that the owner of a lorry could not recover against the consignees the cost of goods transported in it if in the course of the journey it was driven a mile an hour over its permitted speed. If this is really the law, it is very unenterprising of cargo owners and consignees to wait until a criminal conviction has been secured before denying their liabilities. A service of trained observers on all our main roads would soon pay for itself. An effective patrol of the high seas would probably prove too expensive, but the maintenance of a corps of vigilantes in all principal ports would be well worth while when one considers that the smallest infringement of the statute or a regulation made thereunder would relieve all the cargo owners on the ship from all liability for freight.

Of course, as Mr. Wilmers says, one must not be deterred from enunciating the correct principle of law because it may have startling or even calamitous results. But I confess I approach the investigation of a legal proposition which has results of this character with a prejudice in favour of the idea that there may be a flaw in the argument somewhere."

Later on he said at p. 288:

"In my judgment, contracts for the carriage of goods are not within the ambit of this statute at all. A court should not hold that any contract or class of contracts is prohibited by statute unless there is a clear implication, or 'necessary inference,' as Parke B. [*Cope* v. *Rowlands* 2 M. & W. 149, 159] put it, that the statute so intended. If a contract has as its whole object the doing of the very act which the statute prohibits, it can be argued that you can hardly make sense of a statute which forbids an act and yet permits to be made a contract to do it, that is a clear implication. But unless you get a clear implication of that sort, I think that a court ought to be very slow to hold that a statute intends to interfere with the rights and remedies given by the ordinary law of contract."

Just as in the instant case, the court ought to be very slow to hold that the Films (Censorship) Act 1952 intends to interfere with the rights and remedies given by the ordinary law of copyright. Devlin J. continued (288 – 290):

"Caution in this respect is, I think, especially necessary in these times when so much of commercial life is governed by regulations of one sort or another, which may easily be broken without wicked intent. Persons who deliberately set out to break the law cannot expect to be aided in a court of justice, but it is a different matter when the law is unwittingly broken. To nullify a bargain in such circumstances frequently means that in a case – perhaps of such triviality that no authority would have felt it worth while to prosecute – a seller, because he cannot enforce his civil rights, may forfeit a sum vastly in excess of any penalty that a criminal court would impose; and the sum forfeited will not go into the public purse but into the pockets of someone who is lucky enough to pick up the windfall or astute enough to have contrived to get it. It is questionable how far this contributes to public morality. In *Vita Food Products Inc.* v. *Unus Shipping Co.* [1939] A.C. 277, 293, Lord Wright said:

'Nor must it be forgotten that the rule by which contracts not expressly forbidden by statute or declared to be void are in proper cases nullified for disobedience to a statute is a rule of public policy only, and public policy understood

in a wider sense may at times be better served by refusing to nullify a bargain save on serious and sufficient grounds.'

It may be questionable also whether public policy is well served by driving from the seat of judgment everyone who has been guilty of a minor transgression. Commercial men who have unwittingly offended against one of a multiplicity of regulations may nevertheless feel that they have not thereby forfeited all right to justice, and may go elsewhere for it if courts of law will not give it to them. In the last resort they will, if necessary, set up their own machinery for dealing with their own dispute in the way that those whom the law puts beyond the pale, such as gamblers, have done. I have said enough, and perhaps more than enough, to show how important it is that the courts should be slow to imply the statutory prohibition of contracts, and should do so only when the implication is quite clear. I have felt justified in saying as much because, to any judge who sits in what is called the Commercial Court, it must be a matter of special concern. This court was instituted more than half a century ago so that it might solve the disputes of commercial men in a way which they understood and appreciated, and it is a particular misfortune for it if it has to deny that service to any except those who are clearly undeserving of it.

I think also that it is proper, in determining the scope of the statute, to have regard to the consequences I have already described and to the inconveniences and injury to maritime business which would follow from upholding the defendants' contention in this case. In the light of all these considerations I should not be prepared to treat this statute as a nullifying contracts for the carriage of goods unless I found myself clearly compelled by authority to do so. I can find no such authority in the cases which Mr. Wilmers has cited, nor even any analogous cases in which the law has been stretched as far. Of course, the construction of each Act depends upon its own terms, but I can find no authority in which any Act has been given anything like so wide an effect as Mr. Wilmers wants the Act of 1932 to be given. In the statutes to which the principle has been applied, what was prohibited was a contract which had at its centre – indeed often filling the whole space within its circumference – the prohibited act; contracts for the sale of prohibited goods, contracts for the sale of goods without accompanying documents when the statute specifically said there must be accompanying documents; contracts for work and labour done by persons who were prohibited from doing the whole of the work and labour for which they demanded recompense. It is going a long way further to say that contracts which depend for their performance upon the use of an instrument which has been treated in a forbidden way should also be forbidden. In the only case I have seen where the contention appeared to go as far as that the claim failed. The relevant facts in *Smith* v. *Mawhood* [(1845) 14 M. & W. 452, 464] appear sufficiently from the judgment of Alderson B., where he also dealt with the contention:

'But here the legislature has merely said, that where a party carries on the trade or business of a dealer in or seller of tobacco, he shall be liable to a certain penalty, if the house in which he carries on the business shall not have his name, etc., painted on it, in letters publicly visible and legible, and at least an inch long, and so forth. He is liable to the penalty, therefore, by carrying on the trade in a house in which these requisites are not complied with; and there is no addition to his criminality if he makes fifty contracts for the sale of tobacco in such a house. It seems to me, therefore, that there is nothing in the Act of Parliament to prohibit every act of sale, but that its only effect is to impose a penalty, for the purpose of the revenue, on the carrying on of the trade without complying with its requisites.'

A contract for the sale of tobacco was therefore not to be considered void merely because the premises in which the tobacco was sold did not comply with the law. So it might be said that a contract for carriage of goods is not to be considered void merely because the ship in which they are carried does not comply with the law. But I recognize that each case must be determined by reference to the relevant statute and not by comparison with other cases. I reach my conclusion – in the words of Lord Wright in *Vita Food Products Inc.* v. *Unus Shipping Co.* [at p. 295] on 'the true construction of the statute, having regard to its scope and its purpose and to the inconvenience which would follow from any other conclusion.' "

Dato Kandan referred to the case of *Shaw* v. *Groom*[24]. In that case the plaintiff sued the defendant for arrears of rent. The defendant contended that since the plaintiff had failed to provide her with a proper rent book as required by the Landlord and Tenant Act 1962, and the Rent Book (Forms of Notice) Regulations 1965, the plaintiff had committed an offence and was thereby precluded from recovering any rent. Harman L.J. said at p. 514:

"The judge relied mainly on *Anderson Ltd.* v. *Daniel* [1942] 1 K.B. 138, which was a decision of the Court of Appeal and certainly at first reading seems directly in point. In that case the Court of Appeal (Bankes L.J., Scrutton L.J. and Atkin L.J.) held that under the terms of the Fertilisers and Feeding Stuffs Act, 1906, where goods to which the Act of 1906 applied were sold without supplying the invoice there prescribed, the vendor could not recover the price of the goods."

He continued at p. 515:

"[There Bankes L.J.] applied a judgment of Lord Wrenbury, then Buckley J., in *Victorian Daylesford Syndicate* v. *Dott* [1905] 2 Ch. 624, 629, which I do not think I need read, but the effect of which is that the test is whether the end of the statute is to protect the public or to protect the revenue, and that that is the test to apply; and he cited Parke B. in *Cope* v. *Rowlands* (1836) 2 M. & W. 149. Bankes L.J. concluded his citation from Lord Wrenbury, at p. 144:

'If I arrive at the conclusion that one of the objects is the protection of the public, then the act is impliedly prohibited by the statute and is illegal.' "

Later he went on to say at p. 516:

"In my judgment [*Anderson* v. *Daniel*] when looked at carefully, is clearly distinguishable from the present. Here there is nothing illegal in the contract of letting itself

and it could be performed in a perfectly legal manner. Moreover, the landlord in order to enforce it is not obliged to inform the court of his illegal action in failing to provide a rent book. The existence of the rent book is no part of the contract of letting and is purely collateral to it, and this alone distinguishes *Anderson Ltd.* v. *Daniel* [1924] 1 K.B. 138, where the invoice was an essential part of the contract and operated as a warranty under it. The true question is, has the statute impliedly forbidden the contract, and, in my judgment, it has not. The question whether a statute impliedly prohibits the contract in question is one of public policy, as to which, in his speech to the House of Lords in *Vita Food Products Inc.* v. *Unus Shipping Co Ltd.* [1939] A.C. 277, Lord Wright said, at p. 293:

'Nor must it be forgotten that the rule by which contracts not expressly forbidden by statute or declared to be void are in proper cases nullified for disobedience to a statute is a rule of public policy only, and public policy understood in a wider sense may at times be better served by refusing to nullify a bargain save on serious and sufficient grounds.' "

Later on at p. 518, Harman L.J. said:

"Bankes L.J. declared in *Anderson Ltd.* v. *Daniel* [1924] 1 K.B. 138 that the test is whether the statute is for the protection of the public. That that is one test, of course, we would all agree, but I do not think that it can be the only test. The true test is whether the statute impliedly forbids the provision in the contract to be sued upon."

Sachs L.J. in the same case said at p. 520:

"At the outset there thus arises for examination an important question. What is the correct general approach of a court to the question whether a plaintiff suing on a legal contract is precluded from recovering what would otherwise be due to him because in the course of its performance he has done some act in a manner which a particular statute has enacted to be an offence? In particular, does the mere fact that the act is one without which the contract cannot be performed ('an essential act') automatically result in all cases that the plaintiff must fail? For it has been strenuously argued that the provisions of section 4 of the Act of 1962 make the existence of rent books an essential part of the relationship between landlords and weekly tenants.

It has been contended that, although there may be different results where an offence is created to protect the revenue, yet, at any rate, in any case where the offence is created for the benefit of the class of persons to whom the defendant belongs the above result is thus automatic. Is that correct? Or is the correct answer that one must look at the ambit and intent of the particular statute in the light of any other legislation affecting the subject matter, and then decide whether the particular statute intended to preclude the plaintiff recovering on the contract if he had committed the offence? A question of public policy is, of course, involved.

In *Wetherell* v. *Jones*, 3 B. & A. 221 (a case of selling shrub without delivering particulars of how it was compounded), Lord Tenterden C.J. said, at p. 226:

'Where the consideration and the matter to be performed are both legal, we are not aware that a plaintiff has ever been precluded from recovering by an infringement of the law, not contemplated by the contract, in the performance of something to be done on his part.' "

And at p. 521:

"Upon examining the provisions of a statute to ascertain whether its object was to vitiate the performance of a contract as to preclude a plaintiff suing on the contract iself, there may be more than one aspect of public policy to be taken into account. One important aspect is, of course, the desirability of the courts assisting to enforce a statute and not allowing their process to be used by a plaintiff who has broken the penal provisions of that statute. Another element, however, is that stated by Lord Wright in *Vita Food Products Inc.* v. *Unus Shipping Co. Ltd.* [1939] A.C. 277, at p. 293:

'Nor must it be forgotten that the rule by which contracts not expressly forbidden by statute or declared to be void are in proper cases nullified for disobedience to a statute is a rule of public policy only, and public policy understood in a wider sense may at times be better served by refusing to nullify a bargain save on serious and sufficient grounds.'

"Moreover, in *St. John Shipping Corpn.* v. *Joseph Rank Ltd.* [1957] 1 Q.B. 267, Devlin J., after quoting the above words of Lord Wright, said, at p. 288:

'It may be questionable also whether public policy is well served by driving from the seat of judgment everyone who has been guilty of a minor transgression.' "

He went on to observe at p. 522:

"The language used in the judgments in *Anderson's case* is very wide indeed; but even the most eminent judges occasionally use language wider than is strictly needed for the case in hand and are later surprised to find it applied to situations they never had in mind. Few courts have been more strongly composed than that in *Anderson's case*, but their attention was perhaps not drawn to that aspect of public policy with which Lord Wright and Devlin J. were concerned. That may have been because in 1923 the volume of orders and regulations, although already heavy, had not yet attained the present overwhelming proportions."

Sachs L.J. then said at p. 523:

"Despite the width of the relevant passages in the judgments in *Anderson Ltd.* v. *Daniel* [1924] 1 K.B. 138, I have concluded that the correct general approach to the question of preclusion formulated earlier in this judgment is the same as that in the passages just cited from the judgment of Romer L.J. in *Solomons* v. *R. Gertzenstein Ltd.* [1954] 2 Q.B. 243, 266, and the speech of Lord Simonds in *Cutler* v. *Wandsworth Stadium Ltd.* [1949] A.C. 398, 407. One must look at the relevant statute or series of statutes *as a whole* and then assess whether the legislature intended to preclude the plaintiff recovering in the action, even when an essential act is under consideration.

"I am glad to come to a conclusion that accords with the normal rules for interpreting a statute and which avoids

the courts being put into a strait-jacket such as that propounded on behalf of the tenant. Lord Tenterden C.J. in *Wetherell* v. *Jones*, 3 B. & A. 221, 225, spoke of the doctrine by which a plaintiff cannot recover where illegality is established as being founded on 'justice, morality and sound policy.' Assertions that some aspects of morality are best served by producing injustice can lack attraction – and can sometimes hardly accord with 'sound policy.'

"This conclusion is reached on the footing that there has been no change in recent years in the relevant public policy. If, however, it be on the contrary said that the conclusion postulates a less rigid public policy today than obtained in 1924, so be it. Public policy has been often spoken of as an unruly horse: all the more reason then why its riders should not themselves in these changing times wear blinkers, be oblivious to the scene around, and thus ride for a fall. Sound policy must be flexible enough to take into account the circumstances of its own generation. Today's generation is dominated by that ever mounting mass of legislative control to which reference has already been made: in support of that control numberless offences have been created each with its appropriate penalty, and it is for the courts to see that this does not result in additional forfeitures and injustices which the legislature cannot have intended."

I think I have read enough already. I endorse the views of Devlin J. in *St. John Shipping Corpn.* v. *Joseph Rank Ltd.* and the Court of Appeal in *Shaw* v. *Groom*. I think they apply equally to this case. The principles enunciated in those two cases apply as much to the enforcement of copyright. If Golden Star have infringed the Films (Censorship) Act 1952, as they must have, then they could be prosecuted and they would have to pay the penalty. But their rights under the Copyright Act 1969 remain and can be enforced. I do not think that they should be put beyond the pale just because they have committed a transgression of the Films (Censorship) Act. If they were not allowed to enforce their civil rights their loss in financial terms would be greatly in excess of any penalty that a criminal court could impose. The true test is has the Act of 1952 impliedly forbidden the enforcement of the plaintiffs' copyright in the films. In my judgment, it has not. This is not a case where the copyright owner has boldly flouted the law on censorship. Golden Star have in fact applied for the censorship certificates and I am sure they would, in due course, obtain them. Governmental machinery being what it is, some delay is inevitable. Their dilemma is that if the films were not published in this country within 30 days of their being first shown in Hong Kong they would lose their right to enforce their claim to copyright on them. I do not think they should have forfeited their right to justice for doing what they, in their anxiety to preserve their property, have done. The next point is publication.

By section 6(1) of the Copyright Act 1969:

"Copyright shall be conferred by this section on every work which is eligible for copyright and which –

(a) being a ... cinematograph film is first published in Malaysia."

Section 2(2)(c) of the Act provides that:

"a publication in any country shall not be treated as being other than the first publication by reason only of an earlier publication elsewhere, if the two publications took place within a period of not more than thirty days."

From the above provisions, it is clear that for copyright to subsist under section 6(1), the films must be first published in this country. If there were an earlier publication elsewhere, for instance, in Hong Kong as happened to all the films in the present case, such publication in Hong Kong would not be treated as the first publication if it took place within 30 days of the publication in this country. Put in another way, the films were first published in this country if no earlier publication took place in another country more than 30 days from the publication in this country. In other words, the films must be published in Malaysia within 30 days of their being first shown in any country – in this instance, Hong Kong.

Since all the films in this case were first shown in Hong Kong on television and they were all imported into this country and published within 30 days of their being shown (see the affidavit of Mr. Yap Yee Choon dated December 14, 1982, and exhibits YYC 1 and YYC 4), their publication here became the first publication.

But Mr. Wong has argued that the films were not made available in sufficient quantities to satisfy the reasonable requirements of the public. This is what section 2(2)(a) of the Act says:

"a work shall be deemed to have been published if a copy or copies thereof have been made available with the consent of the author in a manner sufficient to satisfy the reasonable requirements of the public;"

There is evidence in Mr. Yap's affidavit that he had supplied to his dealers large quantities of video cassettes of all the 22 titles concerned in this case. The total number of video cassettes involved amounted to 64,267. In *Francis, Day & Hunter* v. *Feldman & Co.*[25] 12 copies of a song composed in America were sent to the plaintiffs in London with instructions to copyright it. 6 copies of the song were exposed for sale on the counter of the

plaintiffs' retail premises in London on May 5, 1913. No copies were sold as there was no demand for it. Much later, the song became popular and was in great demand. Both Neville J. and the Court of Appeal held that the song was "first published" in England on May 5, 1913. Neville J. said at pp. 732 – 733:

"The material words are 'unless the publication in such parts of His Majesty's dominions as aforesaid is colourable only and is not intended to satisfy the reasonable requirements of the public.' There you have really a definition of what 'colourable only' means. It means a case where there is no intention to satisfy the reasonable requirements of the public. In the present case I find no evidence upon which I could come to such a conclusion. It is quite true that the demand anticipated was insignificant and the supply secured to satisfy the demand was also insignificant. A dozen copies were all that were sent at the time, and it was not until some time afterwards that further copies were applied for and forwarded from America. It seems to me that the intention from the first was to satisfy the public demand in this country. In this case I think that is what the publication in England was for. I hold therefore that there was a good publication in England "

Clearly, unlike the song, six copies would not be enough to meet the reasonable requirements of the public in the instant case. But 64,267 video cassettes would be sufficient. Moreover, there was, in fact, no evidence that they would not.

We know from Mr. Yap that the films have reached his dealers – 64,267 video cassettes. But, contended Mr. Wong, we do not know if they have reached the public because the affidavits were silent on this. This seems to me to be rather naive. I should think that one can easily assume they must have because of the tremendous public demand for them. No businessman would let pass such an opportunity. In my judgment, this submission of counsel was misplaced. There is a passage in *Laddie, Prescott & Victoria:* Modern Law of Copyright (1980), p. 169 para. 4.31 which reads as follows:

"However, it appears from the cases that a work may have been published in spite of the fact that members of the public did not physically receive copies, and even if the publication was not advertised or promoted. It is enough if copies were on offer and sufficient stocks were available to meet the anticipated demand."

In *British Northrop Ltd.* v. *Texteam Blackburn Ltd.*[26] Megarry J., after referring to *Francis, Day & Hunter* v. *Feldman,* said at pp. 66 – 67:

"The reported judgment of Neville J. was concerned with whether there had been merely a colourable publication in England; but on page 731 there is an interlocutory observation of his:

'I think 'issued to the public' can mean no more than an invitation or a right to the public to acquire copies. Notice of the publication is given to the public by the copies sent to the British Museum and to the universities. I do not say that that satisfies the Statute. I think it does not, but 'issued to the public' can mean no more than having them on sale. You need not advertise and you need not call the attention of the public to the fact that you have published, if you are prepared to supply on demand. Here, the moment there came a demand they fully satisfied it'.

"I do not forget the warning that Lord Simon, L.C., uttered in regard to interlocutory observations, saying that they are not judicial pronouncements and do not decide anything, even provisionally, but that they are intended to elucidate the argument, point the question or indicate what needs investigation: see (1942) W.N. 89. I should also mention that although the reports of the case at 83 Law Journal (Chancery) 906 and 111 Law Times 521 report other interlocutory observations of the judge, they do not report this. Nevertheless, the observation of Neville, J. seems to me to be of intrinsic cogency. Furthermore, there were the proceedings in the Court of Appeal. The appellants argued that there had been no publication which satisfied the Act of 1911, and that 'there was no issue of copies to the public within section 1(3)'. The appellants then contended that the publication was merely colourable, and that under the Act 'there must be an actual transfer of copies to members of the public'. This met with a single-sentence judgment. Lord Cozens-Hardy, M.R. said at page 733: 'I am clearly of opinion that there was a sufficient publication of this work in this country on May 5, 1913, and Kennedy, L.J. and Swinfen Eady, L.J. concurred.

The actual decision was thus, that the song was published in London on May 5 1913, when copies were exposed for sale, even though no member of the public received any copy until some while later."

He went on to say at pp. 67 – 68:

"Accordingly, in my judgment, under the Act of 1956 an artistic work is 'issued to the public', and so published when reproductions of the work are put on offer to the public. Normally, no doubt, the reproduction will be offered for sale; but I do not see why an offer gratis should not be an offer. Again, no doubt there will usually be some process of advertisement or announcement to the public that the reproductions are on offer; but I agree with Neville, J. in thinking that no such advertisement or announcement is requisite where the person concerned is prepared to supply on demand. I therefore reject Mr. Mervyn Davies' contention that the plaintiffs must fail because they have not proved any positive acts of offer by the plaintiffs. Passive availability suffices, without active offering. In my judgment, subject to the 30 days' rule, the work is first published when it is first put on offer, and the place of first publication is where this occurs."

In my judgment, for the films to be published within the meaning of section 2(2)(a), it is enough if they were on offer and sufficient copies were "available" (or "issued" – to use the terminology of the English Act) to meet the anticipated public demand. According to section 49(2)(c) of the Eng-

lish Copyright Act 1956, a work is "published" if it is *issued to the public.* By our own section 2(2)(a), a work is "published" if it is *made available to the public.* "In relation to copyright," said Lord Wilberforce in *Infabrics Ltd.* v. *Jaytex Ltd.*[27] "whether under common law or statute, 'publishing' and 'publication' are fundamental expressions meaning *making available to the public".*

The video cassettes were with the dealers, who being businessmen, were prepared to supply on demand. The plaintiffs need not prove any positive acts of offer. "Passive availability suffices, without active offering". "You need not advertise and you need not call the attention of the public to the fact that you have published, if you are prepared to supply on demand." I agree with Megarry J. and Neville J. and I endorse what they have said.

But, during submission, Mr. Wong has referred to this passage in *Copinger on Copyright,* twelfth edition (1980), p. 28 para. 70, thus:

"In *Infabrics Ltd.* v. *Jaytex Ltd.* [1980] 1 Ch. 282 the Court of Appeal thought that an offer or exposure for sale would not be publication but any consequent sale which resulted in the issue of reproductions of the work to the public would constitute publication."

That case concerned an action brought by Infabrics against Jaytex for infringement of copyright. The point that went to the Court of Appeal and House of Lords was on the question of infringement under section 3(5)(b) of the English Copyright Act 1956. By this subsection, the acts restricted by copyright in an artistic work, i.e. those acts in which copyright subsists, are: "(a) reproducing the work in any material form;" (not relied on) and "(b) publishing the work." So the type of infringement concerned in that case is for publishing the work. Whitford J. held at first instance [1978] F.S.R. 451 that selling is not issuing copies to the public and therefore not publishing the work. The Court of Appeal[27] held that selling is issuing copies to the public. Buckley L.J. said [at pp. 291 – 292]:

"In my judgment section 3(5)(b) should be construed in accordance with what is, I think, its natural meaning when read in conjunction with section 49(2)(c); that is to say, that publication takes place whenever and as often as reproductions of the copyright work are issued to the public.

"Whitford J. disposed of this point by holding that selling or letting is not issuing copies to the public and so is not publication. ... I feel unable to accept the view that selling or letting is not issuing copies to the public. With deference, therefore, I cannot agree with the judge upon his conclusion on this part of the case. In my judgment the defendants, by selling shirts bearing the 'past the post' design in the United Kingdom to retailers, infringed the plaintiffs' copyright in the design because by doing so they either issued reproductions of the design to the public or authorised the retailers to do so."

The House of Lords held that the words "publishing the work" in section 3(5)(b) of the English Act meant making public in the United Kingdom or other country to which the Act extended a work hitherto *unpublished* in that territory. Since the plaintiffs had failed to establish that their design was *unpublished* when the defendants sold the shirts, the plaintiffs' claim under section 3(5)(b) failed.

I can find nothing in the *ratio* of the decisions which says that "an offer or exposure for sale" would not be publication. Whitford J. held that selling is not publication. The Court of Appeal held that publication takes place whenever and as often as reproductions of the copyright work are issued to the public and that by selling the shirts to retailers the defendants have either issued reproductions of the design to the public or authorised the retailers to do so. – This is no more different from the instant case where Golden Star have also supplied their dealers. – The Court of Appeal thought that section 3(5)(b) applies to any publication. The House of Lords, however, held that infringement of copyright under section 3(5)(b) is confined only to the publication of *unpublished* work.

I think *Copinger* must have the following words of Buckley L.J. in mind (*Infabrics Ltd.* v. *Jaytex Ltd.*[27] at p. 291):

"Mr. Everington has contended that, if 'publishing' in section 3(5)(b) is construed as extending to any publication, this would virtually deprive section 5(3) of any effect. There is force in this argument, but I think that it puts the point too high. A sale by private treaty might, I think, not involve publication. An offer or exposure for sale would not involve publication; but, on the view which I have adumbrated, any consequent sale which resulted in the issue of reproductions of the work to the public would do so."

But those remarks were made *obiter.* They were not necessary to the decision and the point about offer or exposure for sale was not argued. In my judgment, I accept the reasoning of Megarry J. in *British Northrop Ltd.* v. *Texteam Blackburn Ltd. (supra)* and I agree with all that he has said on this point.

One further point remains. Can the plaintiffs sue? Section 14(3) of the Copyright Act 1969 provides that "infringements of copyright shall be actionable at suit of the owner of the copyright". Subsection (7) gives the meaning of "owner of the copyright" as "the first owner, an assignee or an exclusive licensee." Section 12(1) provides that copyright conferred by section 6 shall vest initially in the author. By section 2(1) "author" in the case of a cinematograph film means the person by whom the arrangements for the making of the film were undertaken. TVB and RTV were the makers of the films, so they can sue. Golden Star as the exclusive licensee also can sue: section 14(3) and (7).

In case I am wrong and it turns out that Golden Star have merely a licence and not an exclusive licence, I still say they are proper parties so long as they have joined TVB and RTV as co-plaintiffs: see *Halsbury's* Laws of England, 4th ed., vol. 9, p. 562, para. 880. In fact they are the plaintiffs in the present case. "I do not see why a non-exclusive licensee is not a proper plaintiff in proceedings for breach of copyright provided he joins the owner of the copyright." – said Bowen C.J. in *Young* v. *Odeon Music House*[28].

For the reasons which I have given, I grant the order that is sought.

Order accordingly.

Solicitors: *Shearn Delamore & Co.; Mah-Kok & Din.*

KOPERASI SERBAGUNA CUEPACS TANGGUNGAN BHD. v. CITY INVESTMENT SDN. BHD.

[O.C.J. (Wong Kim Fatt J.C.) May 10, 1982]
[Seremban – Civil Suit No. 189 of 1980]

Land Law – Sale and purchase agreements for 85 housing lots – Dispute – Plaintiffs/purchasers lodged private caveat against said 85 housing lots and also another 100 lots not sold to plaintiffs – Defendants/vendors applied for removal of caveats lodged against 100 lots – Caveats removed by court – Plaintiffs' application for injunction disallowed – National Land Code, s. 329(2)

Practice and procedure – Injunction – Caveats lodged against properties not purchased by caveator – Caveats removed – Injunction against removal of caveats disallowed.

There were 2 written agreements between the defendants/vendors and the plaintiffs/purchasers in which the plaintiffs purchased a total of 85 housing lots from the defendants. The plaintiffs paid $472,000.00 as land purchase price and another sum of $674,300.00 as land development price. Subsequently a dispute arose between the parties over the two agreements. The plaintiffs entered a private caveat against the said 85 lots. The defendants did not dispute that the plaintiffs had caveatable interests in these 85 lots, and did not take any steps to remove the said caveats. The plaintiffs also lodged private caveats against another 100 lots of land not purchased by them but to which they claimed an interest because they contended that the defendants were liable under the agreements to offer these lots in substitution of the 85 lots should any of these 85 lots be not acceptable by the plaintiffs. The defendants' application for the removal of the caveat in respect of the 100 lots was allowed by Ajaib Singh J. The plaintiffs appealed to the Federal Court in F.C.C.A. No. 99 of 1980.

The plaintiffs subsequently applied by *ex parte* summons-in-chambers in the present civil suit for an order of injunction.

Ajaib Singh J. granted the injunction. After obtaining the *ex parte* injunction, the plaintiffs withdrew their appeal to the Federal Court in F.C.C.A. No. 99 of 1980.

The defendants sought for the discharge of the injunction.

Held, allowing the defendants' application: (1) the injunction obtained in the present case appears not to be in the nature of a *Mareva* injunction. There was no evidence to show that the defendants were disposing of assets with a view of defeating a possible judgment in favour of the plaintiffs. It is somewhat akin to a caveat as it restrains the defendant from selling or otherwise dealing with the 100 lots in question;

(2) by withdrawing their appeal in the Federal Court, the plaintiffs had conceded that they had no caveatable interest in the 100 lots of land which they had not purchased. What they had failed to achieve by caveats they could not achieve by injunction based on the same ground;

(3) if the injunction were a second caveat based on the same ground, it could not have been registered owing to the provisions of s.329(2) of the National Land Code;

(4) in applying for an *ex parte* injunction, the applicant is duty bound to disclose in his affidavit all material facts fully and frankly. The plaintiffs had, however, failed to disclose in the affidavit in support of the *ex parte* application for injunction, that the private caveats entered by the plaintiffs in respect of the 100 lots of land had been removed by order of Ajaib Singh J. Had this fact been brought to his attention, the learned judge would not have granted the injunction, for to do so would be to defeat his own order for the removal of the private caveats;

(5) on the balance of convenience the injunction must therefore be discharged.

Editorial Note: Another aspect of this case regarding the question of whether the learned Judicial Commissioner had any jurisdiction to proceed with the trial from the stage at which the previous Judge left it is discussed in detail in F.C.C.A. No. 117 of 1982 at [1983] 2 M.L.J. 33. The appeal proper was argued before the Federal Court (Coram as previously) on March 28, 1983. The said appeal was dis-